

Att'y Dkt. No.: CLON-069
P-146
USPN: 10/055,794

24. (Once Amended) A method of producing an Intron containing vector, said method comprising:

combining a splice sequence comprising donor vector and a splice sequence comprising acceptor vector, wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other, with a recombinase under conditions sufficient for site-specific recombination to occur to produce said intron containing vector.

Cancel Claims 31 to 37.

REMARKS UNDER 37 CFR § 1.111

Claims 2-11 and 21-30 are pending after entry of the amendments set forth herein.

Claims 1-37 were examined and were rejected.

Claim 2 has been amended to incorporate the limits of Claim 1, and Claims 22 and 24 have correspondingly been amended. The additional amendments to the dependent claims have been made solely to bring these dependent claims into compliance with their independent claims from which they depend. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**" As the above amendments introduce no new matter to the application, their entry by the Examiner is respectfully requested.

At the top of Page 2 of the Office Action, a request was made to provide a sequence listing for the sequences shown on pages 17 and 18 of the specification.

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However, David Guzo informed the undersigned in a message dated September 17, 2002 that a sequence listing for these sequences was not in fact required under the rules. As such, the specification has not been amended to include sequence id numbers and no sequence listing is attached.

With respect to the drawings, formal drawings are being submitted herewith.

Claims 1, 7-24 and 27-37 have been rejected under 35 U.S.C. §102 (b) as lacking novelty over Griffiths. In view of the above amendments in which Claim 1 has been incorporated into Claim 2, which claim was found free of the prior art by the Examiner, as well as the amendment of Claims 21 and 24 to include the same limitation of Claim 2, this rejection may be withdrawn.

The Applicant notes that the above amendments and claim cancellations have been made solely to expedite allowance of the present application and should not be construed as an agreement by the Applicant with the Examiner's position regarding the canceled claims and the cited prior art. The Applicant expressly reserves the right to pursue these canceled claims in a continuation application, and the Applicant still regards these canceled claims as patentable over the prior art cited by the Examiner.

Conclusion

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue.

MAR-09-04 TUE 04:24 PM BOZICEVIC
2004/MAR/09/TUE 04:56 PM BD LAW DEPT

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FAX No. 201 848 9228

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If the Examiner finds that a Telephone Conference would expedite prosecution of this application, he is invited to contact the undersigned (650) 327-3400.

In the event that the transmittal letter is separated from this document and the Patent Office determines that extensions or other relief is required and/or fees are due applicants, the Applicant petitions for any required relief, including extensions of time, and authorize the Commissioner to charge our Deposit Account No. 50-0815, Order Number CLON-069, for any fees due in connection with the filing of this document. The Patent Office is not authorized to charge issue fees to our Deposit Account.

Respectfully submitted,

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Date: 9.19.02

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Cancel Claim 1.

2. (Once Amended) ~~The system according to Claim 1, A sequence specific recombinase based system for use in preparing an intron containing vector, said system comprising:~~

a donor vector comprising at least one splice site and an acceptor vector comprising at least one splice site, wherein said donor and acceptor vectors each comprise at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other.

7. (Once Amended) The system according to Claim 2 4, wherein said system further comprises a sequence specific recombinase.

8. (Once Amended) The system according to Claim 2 4, wherein said recombinase recognition sites are selected from the group consisting of: lox sites, att sites, dif sites and frt sites.

9. (Once Amended) The system according to Claim 2 4, wherein said donor and acceptor vectors are plasmids, cosmids, bacs, yacs or viruses.

10. (Once Amended) The system according to Claim 2 4, wherein said system further comprises a host cell.

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11. (Once Amended) The system according to Claim 2, wherein each of said donor and acceptor vectors comprise a splice donor and a splice acceptor sequence.

Cancel Claims 12 to 20.

21. (Once Amended) A kit for use in producing an expression vector, said kit comprising:

at least one of:

- (a) a donor vector comprising a splice site; and
- (b) an acceptor vector comprising a splice site;

wherein each of said donor and acceptor vectors further comprises at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other.

24. (Once Amended) A method of producing an intron containing vector, said method comprising:

combining a splice sequence comprising donor vector and a splice sequence comprising acceptor vector, wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other, with a recombinase under conditions sufficient for site-specific recombination to occur to produce said intron containing vector.

Cancel Claims 31 to 37.

BOZICEVIC, FIELD & FRANCIS LLP**OUTGOING MAIL LOG
SEPTEMBER 19, 2002**

| Atty. Docket No. | Serial Number | Description | Atty. | Fee | Billing Code |
|------------------|---------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------|---------|--------------|
| YAMA-007 | 09/543,449 | Fee Address Indication | BEF | | |
| BERK-001CON2 | 08/966,398 | Fee Address Indication | BEF | | |
| CLON-069 | 10/055,794 | Transmittal, Amendment, Formal Drawings Transmitted, 5 Sheets of Figures | BEF | | D28, D61 |
| +UCAL-105CIP2 | 10/040,315 | Fax Cover, Request for Corrected Notice of Recordation, Copy of Incorrect Notice | BEF | | D71 |
| +BERK-017 | 10/136,860 | Fax Cover, Request for Corrected Notice of Recordation, Copy of Incorrect Notice | BEF | | D71 |
| UCSF-129 | 09/535,145 | Transmittal, Amendment After Final Rejection, Appendices A-C | JSK | | D64 |
| +UCAL-263CON | 09/920,085 | Fax Cover, Transmittal, Restriction Election | PAB | | D57 |
| +STAN-110CON | 09/837,446 | Fax Cover, Transmittal, Fee Transmittal in duplicate, Preliminary Amendment/Response to Restriction Requirement, Petition for a 4 Month Extension of Time | JSK | \$720 | D57 |
| CLON-033CIPCON | 10/117,825 | IDS, SB08A, 1 Cited Reference | BEF | | D22 |
| LIFE-069 | 09/784,993 | Transmittal, PTOL-85B in duplicate, Associate Power of Attorney | CML | \$1610 | D23 |
| *TOSK-007WO | | Transmittal of Express Mail, PCT Request, Fee Sheet, (2) PCT POA's, Specification, Claims, Abstract, 7 Sheets of Figures, (1) PCT IEZ Diskette Express Mail No. EV012444324US | BEF | \$1,499 | D54 |
| AERX-091 | | Utility Patent Application Transmittal, ADS, specification, Claims, Abstract, 4 Sheets of Figures Express Mail No. E11779661497US | FPB | | D21 |
| +DURE-007 | 09/522,535 | Fax Cover, Transmittal, Amendment After Final | CLF | | N/A |

+ Indicates after hours filing.

* Indicates error(s) within original filing.